UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/606,053	06/28/2000	Eric Lauzon	584-1027	5671

23644 7590 01/26/2005	EXAMINER
BARNES & THORNBURG P.O. BOX 2786 CHICAGO, IL 60690-2786	HARTMAN JR, RONALD D

ART UNIT	PAPER NUMBER
2121	

DATE MAILED: 01/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>08 November 2004</u>.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-11,14 and 15</u> is/are pending in the application.

4a) Of the above claim(s) <u>12-13 and 16-24</u> is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-11 and 14-15</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on <u>28 June 2000</u> is/are: a)☐ accepted or b)☒ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____.

DETAILED ACTION

Response to Arguments

1.   In view of the Appeal Brief filed on 11/08/2004, PROSECUTION IS HEREBY REOPENED, and a newly found reference serves as the basis for the new grounds of rejection, as set forth below in this office action.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) request reinstatement of the appeal.

If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no new amendments, affidavits (37 CFR 1.130, 1.131 or 1.132) or other evidence are permitted. See 37 CFR 1.193(b)(2).

In the Appeal Brief, the applicant has argued that the prior art of Edwards et al. does not teach or adequately suggest, "associating computer software code with at least signaling protocol message". In so much as the examiner concurs with the applicant's arguments with respect to claim 14, since pending claim 14 sets forth an "SIP message", the rejection of claim 14 will be withdrawn. However, upon further search and consideration, and in light of the applicant's statements that the claimed message cannot be an email message, additional references were discovered, and are appropriately applied in the rejections set forth below in this office action.

That being said, rather than continue utilizing Edwards et al. for rejection purposes, since the applicant has stated it may not be properly applied since the claimed "SIP signaling protocol message" is not the equivalent of an "email message", the examiner has applied another reference located after further search of the prior art. Also, it is worth noting that claim 1 does not set forth the SIP feature that the applicant has used as the basis for this argument.

The examiner, before relying on the other rejections set forth below, would like to point out that "signaling protocol message" is not defined by the specification, as originally filed, and therefore the examiner is left to interpret this term in light of the applicants disclosure and the relevant prior art. After reviewing the provisional application to which the pending claims claim priority, 60/171,777 and 60/171,801, it appears that the applicant is claiming essentially "JAVA enhanced SIP" for Internet telephony communication systems, and the signaling protocol message is interpreted as being the equivalent to a packet, the typical means of transport in an SIP communication system. Therefore, a rejection based on a system with substantially similar properties, formed under the name of "ChaiTime", was located and has been applied.

The examiner's response to any other arguments, with respect to Edwards et al., have been rendered moot in view of the new grounds of rejection set forth below in this office action.

Minor Informalities

2.   Claim 2 should end with a period.

Drawings

3.   New corrected drawings in compliance with 37 CFR 1.121(d) are required in this application because Figure 16 has hand written features and or elements which are not suitable for reproduction. Applicant is advised to employ the services of a competent patent draftsperson outside the Office, as the U.S. Patent and Trademark Office no longer prepares new drawings. The corrected drawings are required in reply to the Office action to avoid abandonment of the application. The requirement for corrected drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

4.   The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly
> claiming the subject matter which the applicant regards as his invention.

Claim 3 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 3 recites the limitations "the identity" and "the caller" in line 2. There is insufficient antecedent basis for these limitations in this claim.

Claim 8 recites "the accessed configuration information" in lines 2-3. There is insufficient antecedent basis for these limitations in this claim. It appears that this claim (claim 8) should depend from claim 7, not claim 6 as currently presented. This is how the examiner, for rejection purposes, will interpret this claim.

Claim 10 recites "the called party" in line 3. There is insufficient antecedent basis for these limitations in this claim.

Claim Rejections - 35 USC § 102

5.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
> (a) the invention was known or used by others in this country, or patented or described in a printed
> publication in this or a foreign country, before the invention thereof by the applicant for a patent.

6.   Claims 1, 7-8, 11 and 14 are rejected under 35 U.S.C. 102(a) as being anticipated by the article entitled, "ChaiTime: A System for Rapid Creation of Portable

Next-Generation Telephony Services Using Third-Party Software Components"
(Hereafter: Anjum).

As per claims 1 and 11, Anjum teaches a method of remotely controlling a
destination terminal from an originating terminal, wherein the destination terminal has
an associated signalling protocol client and an associated processor, the method
comprising the steps of:

- associating computer software code with at least one signaling protocol
message (e.g. Examiner interprets this limitation to correspond to the use of
JavaBeans, servlets or applets which are used in an SIP, session initiation protocol,
communication network; page 25, 1st column, "As shown in Figure 2...");

- sending the signaling protocol message to the destination terminal from
the originating terminal (e.g. Examiner interprets this limitation to correspond to Anjum's
teaching of a dynamic service download wherein a destination terminal, terminal B, is
invited to join a communication session with an originating terminal, terminal A; page
22, "Example Scenario: Dynamic Service Download. In this scenario, a service can be
activated ..."); and

- executing the computer software code using the processor associated
with the destination terminal in order that the software code controls the destination
terminal (e.g. Examiner interprets this limitation to correspond to the destination
terminal, terminal B, downloading appropriate resources after being instructed
specifically where to find the resources; page 22, "Example Scenario: Dynamic Service
Download. In this scenario, a service can be activated ..." and page 30, "Use of SIP").

As per claim 14, the rejection of claim 1 is equally applied herein as these
features, that is, the use of a destination terminal, in addition to the other claimed
features, is adequately contemplated by the rejection of claim 1.

As per claims 7-8, Anjum teaches the software code arranged to access
information about the configuration of the destination terminal (e.g. Examiner interprets

this limitation to correspond to Anjum's teaching of automatically and transparently configuring the destination terminal so as to allow both terminals to utilize a common communication session; See Example Scenario: Dynamic Service Download).

7.   Claims 1 and 14 are rejected under 35 U.S.C. 102(e) as being anticipated by or, in the alternative, under 35 U.S.C. 103(a) as being obvious over Donovan et al., U.S. Patent No. 6,615,236.

        As per claims 1 and 14, all of the features are believed to be adequately anticipated by an SIP communication system having extended feature control capabilities. This system is clearly taught by Donovan et al. in that Donovan et al. discloses an SIP based control telephone system, and all of the features of claims 1 and 14 are believed to be inherent to an SIP network, with is exactly what is disclosed by Donovan et al. (See Donovan et al., Entire Disclosure, specifically C1 L50-65),

        It is worth mentioning that claims 1 and 14 only require software code, and since the specification does not require the "code" to be code that is only interpretable by a computer, written text, as disclosed by Donovan et al.'s CIP telephone control system, is not excluded, and as it is clearly taught in Donovan et al. (See C4 L18-30, C4 L50-62 and C5 L13-23), it satisfies the loose requirements set forth by the definition of code from the applicant. Therefore, for at least the aforementioned reasons, all of the features and or limitations of claims 1 and 14 and believed disclosed or rendered inherent by an SIP communication network, the system taught by Donovan et al.

Claim Rejections - 35 USC § 103

8.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

9.   Claims 2-6, 9-10 and 15 are rejected under 35 U.S.C. 103(a) as being
unpatentable over Anjum, as applied to claims 1 and 14 above, in view of Schuster et
al., U.S. Patent No. 6,584,490.

As per claims 2-6, 9-10 and 15, although Anjum teaches a terminal component
being utilized for providing a speed dialing service, Anjum does not specifically teach
the components performing the following functions: functions for security purposes,
functions for caller id and display, functions for utilizing priority levels of incoming calls,
functions for call forcing, functions for configuration of terminating services and
functions for call forwarding.

Schuster teaches a plethora of call control features, the call control features
including priorities, voice mail routing, changing of operation parameters (configuration),
caller ID and call forcing (C1 L27 – C2 L49), that is, it is believed that Schuster
adequately discloses all of the aforementioned call control features which are absent in
the teachings of Anjum.

Since Schuster teaches the need for these call control features in an IP
telephony system, and since Anjum teaches the use of an IP telephony system which
utilizes an SIP communication protocol so that communication sessions between
terminals can be effectively and efficiently managed, the incorporation of the call control
features disclosed by Schuster would obviously benefit the system of Anjum by
providing many advanced call control functions that were well known at the time the
invention was made, thereby forming a more effective way of controlling and or
managing communication sessions between individual user terminals, and this would
have been obvious at the time the invention was made.

10.   Claims 1 and 14 are rejected under 35 U.S.C. 103(a) as being obvious over
Donovan et al., U.S. Patent No. 6,615,236.

As per claims 1 and 14, all of the features are believed to be adequately
anticipated by an SIP communication system having extended feature control
capabilities. This system is clearly taught by Donovan et al. in that Donovan et al.
discloses an SIP based control telephone system, and all of the features of claims 1 and

14 are believed to be inherent to an SIP network, with is exactly what is disclosed by Donovan et al. (See Donovan et al., Entire Disclosure, specifically C1 L50-65),

It is worth mentioning that claims 1 and 14 only require software code, and since the specification does not require the "code" to be code that is only interpretable by a computer, written text, as disclosed by Donovan et al.'s CIP telephone control system, is not excluded, and as it is clearly taught in Donovan et al. (See C4 L18-30, C4 L50-62 and C5 L13-23), it satisfies the loose requirements set forth by the definition of code from the applicant. Therefore, for at least the aforementioned reasons, all of the features and or limitations of claims 1 and 14 and believed to be either taught or rendered obvious by the disclosure of an IP telephony system utilizing an SIP communication network, and this would have been obvious to one of ordinary skill in the art at the time the invention was made.

Withdrawn Claims

11.   Claims 12-13 and 16-24 have been withdrawn from consideration, and as such, the applicant is once again reminded that they should be canceled in response to this office action.

Conclusion

12.   Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ronald D Hartman Jr. whose telephone number is (571) 272 - 3684. The examiner normally works Mon. - Fri., 10:30 am - 8:00 pm EST. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anthony Knight can be reached at (571) 272 - 3687. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

you have questions on access to the Private PAIR system, contact the Electronic
Business Center (EBC) at 866-217-9197 (toll-free).

Ronald D Hartman Jr.

Patent Examiner

Art Unit 2121

x RDH

Anthony Knight
Supervisory Patent Examiner
Group 3600